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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,317	10/20/2000	Kia Silverbrook	ART85US	8404
24011	7590	02/09/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,317

Applicant(s)

SILVERBROOK ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunoshita (US 6,603,864) in view of Soscia (US 5,996,893), Mui (US 6,160,642), and Soscia (US 5,996,893).

Regarding claim 6: Matsunoshita teaches an apparatus (fig. 20) for reproducing an image depicted in a print media (column 18, lines 8-9), the print media also carrying digital encoded data (e.g., bar codes, column 17, lines 50-60, additional data, column 18, lines 1-20) printed in invisible ink (column 17, line 53), the apparatus comprising: a scanner (scanner, column 18, lines 1-10) means for scanning the digital data; means (lamp 78, lines 50-60) for illuminating the print media with invisible radiation; means for processing data output from the scanner means, the means (column 18, lines 12-35) for processing data including means for decoding (inherently, all signals must be decoded to come up with the e.g., copyright ID information, column 18, lines 12-15, in a computing device) the digitally encoded data scanned by the scanner means; and printing means (column 16, lines 60-67) for receiving data from the means for processing data to print the image depicted in the print media; wherein the data used to print the image is derived from the digitally encoded data (decoded additional data,

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column 18, lines 10-20 and additional data can be sent from the computer to a printer to be printed, column 15, lines 20-30; note).

Matsunoshita does not teach the print media is a photograph with printed invisible digital data. However, scanning a photograph is inherent properties of a scanner.

Soscia, in the same area of printing and scanning invisible image on a printed media (column 1, lines 40-45, column 5, lines 30-40, column 6, lines 60-65), teaches scanning a photograph (column 1, lines 40-45) printed with digital images (column 5, lines 30-40, column 6, lines 60-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the print media of Matsunoshita to include a photographs with digital data printed in invisible ink.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the print media of Matsunoshita by the teaching of Soscia because of the following reasons: (a) since digital camera becomes more popular, it is desirable of creating photographs having digital data printed with invisible ink, column 1, Soscia; and (b) it would have allowed Matsunoshita's system to be widely used by users of digital camera without any modification to the system of Matsunoshita.

Matsunoshita also does not disclosed an ADF for advancing the print media.

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However, Mui in the same area of scanning photograph (column 3, lines 43-45), teaches it is well known in the art to provide an ADF for advancing print media (column 1, lines 60-66).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Matsunoshita to include: an ADF for advancing the print media.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Matsunoshita by the teaching of Mui because it would have saved users a lot of effort of advancing the photograph manually.

Matsunoshita does not disclosed an inkjet printer.

Soscia, in the same area of printing teaches it is well known in the art to print images using ink, including invisible ink, by an inkjet printer (abstract, column 3, lines 15-35, column 4, lines 5-20).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have used an inkjet printer for printing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have used an inkjet printer for printing because: an inkjet printer is well known to be very reliable and cheap, and would have created an reliable and lost cost product for Matsunoshita.

Note: although Matsunoshita teaches sending additional data with the image data to the computer and the computer sending additional data and image data to the image processing apparatus to be printed in two different embodiment; it would have

been obvious to a person with ordinary skill in the art to take the received additional data with the image data in one embodiment and send it to the image processing apparatus as taught by another embodiment because computer that is capable of receiving and transmitting data would be able to transmit the received data and to fully utilize Masunoshita's invention.

In accordance with claim 3, Matsunoshita discloses using IR ink as the invisible ink (col. 16 line 6).

In accordance with claim 4, Matsunoshita discloses wherein the ink jet printer means includes means for printing out on a print media attached to the ink jet printer means both the image depicted in the photograph and the digitally encoded data, said digitally encoded data being printed in invisible ink in an encoded form, said image and image data being derived from the decoded data (col. 16 lines 4-6 and 8-9).

3. Claims 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunoshita (6,603,864) in view of Soscia (US 5,996,893) and Mui as applied to claim 1 above, and further in view of Zhang (US 5,771,245).

In accordance with claims 2 and 5, Matsunoshita does not disclose expressly that the digitally encoded data is encoded and decoded using the Reed-Solomon process.

Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4 lines 18-20).

Matsunoshita and Zhang are combinable because they are from the same field of endeavor, namely two-dimensional data encoding and decoding.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the encoding/decoding process in Matsunoshita's system.

The motivation for doing so would have been that the Reed-Solomon process is a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

Response to Arguments

4. Applicant's arguments, see amendment, page 3, filed 1/5/2006, with respect to the rejection(s) of claim(s) 6 under Matsunoshita (US 6,603,864) in view of Soscia (US 5,996,893), Mui (US 6,160,642), have been fully considered and are persuasive. It is persuasive because Matsunoshita does not mention ink jet printer. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Matsunoshita (US 6,603,864) in view of Soscia (US 5,996,893), Mui (US 6,160,642), and Soscia (US 5,996,893).

Please see detailed office action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 23, 2006

A handwritten signature in black ink, appearing to read 'K. Y. Poon', with a stylized flourish at the end.

**KING Y. POON
PRIMARY EXAMINER**

1/23/06